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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF   :

HIROAKI SAKAGUCHI   : EXAMINER: TURCHEN, J. R.

SERIAL NO: 10/743,088   :

FILED: DECEMBER 23, 2003   : GROUP ART UNIT: 2139

FOR: INFORMATION PROCESSING   :
APPARATUS AND METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in

accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

This request is being filed with a Notice of Appeal.

The Final Action (hereinafter "FA") mailed June 14, 2007, presented a rejection of

Claims 7 and 11 under the first paragraph of 35 U.S.C. §112, a rejection of Claims 1, 4, 6, 7,

11 and 19 under 35 U.S.C. §103(a) as being unpatentable over Belu (U.S. Published Patent

Application No. 2002/0033762) in view of Videcrantz et al. (U.S. Patent No. 6,275,588,

Videcrantz), and a rejection of Claims 12-15, 18, and 20 under 35 U.S.C. §103(a) as being

unpatentable over Belu in view of Videcrantz and Gabon (U.S. Patent No. 5,943,421).

The Advisory Action (hereinafter "AA") mailed October 12, 2007, indicated that the

rejection of Claims 7 and 11 under the first paragraph of 35 U.S.C. §112 was withdrawn

based upon the Request for Reconsideration (hereinafter "RR") filed September 13, 2007,

while further maintaining the above-noted rejections under 35 U.S.C. §103(a).

The "RR" noted that independent Claim 1 is a "means-plus-function" claim and, thus, the PTO was required to construe the scope of the structures disclosed in the specification for the claimed "means," and explain how the "means" as disclosed in the specification are structurally equivalent to the relied upon elements embodied in the references. The exact function of each claimed "means" also needed to be defined by the PTO that also needed to explain how the relied upon reference elements can be said to perform identical functions. *See Gechter v. Davidson,* 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997).

The "RR" noted that the "FA" failed to follow this required analysis as it never properly construed the Claim 1 "first generation means" or its function of "generating and outputting first auxiliary data including a total number of individual programs combined and compressed by the compression means and a size of each individual program combined and compressed by the compression means."

Page 3, lines 14-16 of the "FA" improperly relied on the teachings of paragraphs 40-42 of Belu (as to "a file header that contains auxiliary data such as the names, sizes, compressed sizes, etc.") as corresponding to this "first generation means" and as to performing the above-noted function of "generating and outputting first auxiliary data." However, the "RR" noted that this reliance was improper because a file header does not generate or output anything by itself and is not the "equivalent" of the CPU disclosed in the specification (at page 11, lines 18-24) to count "the number of programs" and to calculate "the size of each of the programs."

The continuation sheet (page 2) attached to the "AA" improperly seeks to belatedly suggest that "Belu inherently discloses the compression means and the generation means." However, the "AA" cannot serve to inject a new rationale for the rejection and still fails to explain how Belu inherently discloses the generation means or its recited function. The

newly relied upon paragraph [0022] of <u>Belu</u> is only concerned with the compression of

multiple files, not with the Claim 1 required "first generation means" or its function.

Also, a mere conclusion of "inherency" based on less than an absolute certainty as to

the internal components of a "computer" is improper because it lacks the required "extrinsic

evidence" that "must make clear that the missing descriptive matter is necessarily present in

the thing described in the reference, and that it would be so recognized by persons of ordinary

skill." *See In re Paulsen*, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) as to the uncertain

contents of a "computer" as follows:

> The term "computer" is not associated with any one fixed or rigid
> meaning, as confirmed by the fact that it is subject to numerous definitions and
> is used to describe a variety of devices with varying degrees of sophistication
> and complexity.

As further noted in the "RR," the FA improperly relies on an <u>undocumented</u> assertion

of what is "well known" as to counting a number of files. The "AA" attempts to improperly

add a reference (as to Winzip mentioned as to a previous rejection of Claim 17, see lines 16-

17 on continuation page 2) to the outstanding stated rejection of the "FA" as to counting the

number of files. However, Winzip is not included in the rejection in the "FA."

<u>Videcrantz</u> does not correct the above-noted deficiencies of <u>Belu</u>.

Independent method Claim 6 is rejected under the same reasoning as independent

Claim1 at page 4 of the "FA." This reasoning cannot support the rejection of Claim 6 for the

same reasons it cannot support the rejection of Claim 1.

Independent Claim 7 is again a "means-plus-function" claim that has not been

properly construed as noted above relative to *Gechter v. Davidson* decision. Also merely

noting (as at the bottom of page 4 of the "FA" that the header portion "is readily available to

be recreated including the list of file headers" is not a tweaching found in the relied upon

references. Examiner speculation cannot be used in place of reference teachings. *See In re*

Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) and *In re Lee*, 217 F.3d

1365, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

Moreover, Claim 7 requires far more than just decryption with decompression noted

in the "FA" because it requires "creation means <u>operatively connected to the decryption

means</u> for receiving the decrypted first auxiliary data and for creating <u>a management table

about locations of individual ones of said plurality of individual programs based on said

decrypted first auxiliary data</u>" and it requires a "memory means <u>operatively connected to

receive the decompressed and combined individual programs from the decompression means

and to receive the management table from the creation means</u> and for storing the

decompressed and combined individual programs and said management table" (emphasis

added). Rather than address the express claim limitations and required connections, the

bottom of page 4 of the "FA" improperly relies on inherency as to storage that is at best a

mere possibility, not a certainty.

As note above, <u>Videcrantz</u> does not correct the above-noted deficiencies of <u>Belu</u>.

Independent method Claim 11 is rejected under the same reasoning as independent

Claim 7 at page 5 of the "FA." This reasoning cannot support the rejection of Claim 11 for

the same reasons it cannot support the rejection of Claim 7.

Further, as Claim 4 depends on Claim 1 and Claim 19 depends on Claim 6, the

rejection applied thereto is improper for the reasons noted above as to these parent claims.

The rejection of independent Claim 12 at page 5 of the "FA" repeats the reliance on

<u>Belu</u> as to the above noted improper rejections of Claims 1 and 7. <u>Videcrantz</u> and <u>Gabon</u> do

not correct the above-noted deficiencies of <u>Belu</u> and the rejection of Claim 12 is improper for

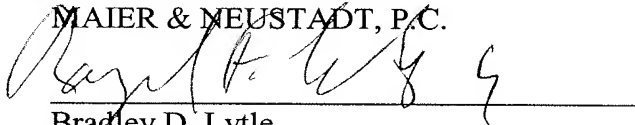the reasons noted above as to these deficiencies of <u>Belu</u>.

Independent method Claim 18 is rejected under the same reasoning as independent

Claim12 at page 6 of the "FA." This reasoning cannot support the rejection of Claim 18 for

the same reasons it cannot support the rejection of Claim 12.

Also, as Claims 13-15 ultimately depend on independent Claim 12 and Claim 20

depends directly on independent Claim 18, the rejection applied thereto is improper for the

reasons noted above as to these parent claims.

Based on the above-noted deficiencies in the "FA" and the "AA,", Applicant notes

that there are no actual issues for appeal and respectfully submit that the application should

be allowed based upon existing Claims 1, 4, 6, 7, 11-15, and 18-20.

Respectfully submitted,

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